

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ute Heim et al.

Application No.: 10/565,221

Confirmation No.: 7312

Filed: February 28, 2006

Art Unit: 1638

For: EXPRESSION CASSETTES FOR THE BI-
DIRECTIONAL TRANSGENIC EXPRESSION
OF NUCLEIC ACIDS IN PLANTS

Examiner: Page, Brent T.

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed October 30, 2007, Applicants hereby provisionally elect SEQ ID NO: 2 for further prosecution with traverse. Reconsideration and withdrawal of the restriction requirement is strongly urged for the following reasons.

The Claimed Inventions Share a Special Technical Feature

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. An application “shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.” (PCT Rule 13.1). Unity of invention is fulfilled “when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression ‘special technical feature’ shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” (PCT Rule 13.2).

The Examiner alleges that the inventions listed as SEQ ID NO: 1 or SEQ ID NO: 2 are distinct because they lack the same or corresponding special technical feature under PCT Rule 13.2. In support, the Examiner states that the alleged special technical feature is a promoter sequence which is known in the art, citing to Benfry et al. (Science, 250: 959-966, "Benfey"). Applicants respectfully disagree with the Examiner's characterization of the invention.

As stated in the specification, the general inventive concept of the present application relates to expression cassettes and vectors which comprise plant bidirectional promoters, and their use for transgenic expression of nucleic acids in plant organisms. See Specification at page 1, lines 3-5 and page 2, lines 24-27. As the Examiner correctly characterized, Benfey discloses the characterization of the CaMV promoter. See Office Action at page 2. However, Benfey does not disclose the promoters of the present invention, namely bidirectional promoters. See, e.g., Specification at page 1, lines 26-28 (regulatory sequences which result in transcription of the upstream and downstream DNA sequences in both directions). Therefore, Benfey does not disclose the special common technical feature of the promoter that would result in transcription of DNA sequences in both directions. The claims therefore should not be restricted to one of the two promoter sequences.

Moreover, Applicants believe that there is no undue burden on the Examiner to search both sequences together. As stated in § 803 of the M.P.E.P. "[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (M.P.E.P. § 803, emphasis added). As discussed above, the two promoter sequences share a common feature of promoter function (i.e. bidirectional). Furthermore, a sequence alignment indicates that these two promoter sequences share 100% sequence identity in the overlapping area. Thus, the same art and field of search relevant to one promoter sequence would be also relevant to the other promoter sequence. No undue burden would be required in examining them together. Accordingly, Applicants respectfully request that the Examiner reconsider the restriction requirement and examine all the claims in one application.

The International Examiner Found Unity of Invention

Furthermore, unity of invention was found during the international stage. As shown in the International Preliminary Report on Patentability and the International Search Report, all

claims were searched and examined together. Thus, application of PCT Rules 13.1 and 13.2 by the International Examiners shows that unity exists. Since the search has already been conducted by the International Search Authority and the International Examination Authority and no lack of unity of invention has been found, for this additional reason, there would be no undue burden on the Examiner to examine both promoter sequences in one application.

CONCLUSION


For at least the above reasons, Applicants respectfully request that the restriction requirement be reconsidered and withdrawn.

Applicants reserve all rights to pursue the non-elected species in one or more divisional application.

Applicants enclose herewith a copy of the English translation of the International Preliminary Report on Patentability. The references cited therein have been previously submitted to the Patent Office. Please note that the "D1" reference (WO 03/006660) corresponds to CA 2,454,127 cited in the IDS and SB-08 filed on January 19, 2006.

Applicants are submitting their response within the one-month response period. No fee is believed due. However, if any fee is due, the Director is hereby authorized to charge our Deposit Account No. 03-2775, under Order No. 13173-00022-US from which the undersigned is authorized to draw.

Respectfully submitted,

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